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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,114	11/14/2000	Brian Harniman	17200-067US1	4946
54205 7590 11/28/2007 CHADBOURNE & PARKE LLP 30 ROCKEFELER PLAZA NEW YORK, NY 10112			EXAMINER NELSON, FREDA ANN	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/716,114

Applicant(s)

HARNIMAN ET AL.

Examiner

Freda A. Nelson

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-12 and 14-199 is/are pending in the application.
- 4a) Of the above claim(s) 15-72, 81-132 and 141-194 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12, 14, 73-80, 133-140, and 195-199 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment received on October 31, 2007 is acknowledged and entered.

Claims 1, 73, and 133 have been amended. Claims 15-72, 81-132, and 141-194 have been withdrawn. Claims 8 and 13 have been canceled. Claims 195-199 have been added. Claims 1-7, 9-12, and 14-199 are currently pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

#### ***Response to Amendment and Arguments***

Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., bounce back offer to acquire a second product may lead to a new transaction with a supplier-partner) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments that Tavor does not anticipate the claimed invention wherein the bounce back offer to acquire a second product may lead to a new transaction with a supplier-partner through hyperlinks...available to the user", the examiner respectfully disagrees.

Tavor discloses hereinafter, the term "discount incentive" refers to an incentive for a user to purchase a product, including but not limited to, a discount in the price of the product, a present (such as an additional product at a low cost or at no additional cost), a benefit (such as a "buyers club" card) and a discount in the price of shipping the product (col. 2, lines 56-64). Tavor further discloses the "StartP3Scr" neural network used the global parameters as well as parameters such as: whether a negotiation process took place in the current session and whether the user is a member of the merchant's loyalty club (col. 8, lines 16-23).

In response to applicant's arguments that neither Microsoft Office 2000 Professional edition nor the Logan patent remedy the Tavor does not anticipate submitting a conditional purchase offer, receiving an acceptance indication of the conditional purchase, the examiner respectfully disagrees. The electronic negotiation with an offer price and a discount incentive of Tavor, see column 2, lines 9-41, is seen to disclose the claimed conditional purchase offer with bounceback offer, and the bounceback further explained, see column 2, lines 55-61 and column 14, lines 5-23.

***Examiner's Note***

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 5, 9-12, 73, 77, 80, 133, 137, 140 and 198-199 are rejected under 35 U.S.C. 102(e) as being anticipated by Tavor et al. (US Patent Number 6,553,347).

As per claims 1, 73, 133, 195, and 199, Tavor et al. ('347) discloses :

transmitting a conditional offer to acquire a first product or service, said conditional purchase offer including a customer-specified price (col. 2, lines 9- 33);

receiving an acceptance of said conditional purchase offer and a bounce back offer to acquire a second product or service as part of an independent bounce back transaction with a hyperlink to a cobranded web site (col. 2, line 30-61; (col. 8, lines 16-23; col. 9, line 46 – col. 10, line 32; col. 14, lines 5-23);

accessing said cobranded web site to effectuate said bounce back transaction with a supplier-partner for said second product or service (col. 9, line 46-col. 10, line 32).

As per claims 5, 77, 137 and 198, Tavor et al. ('347) further discloses a jump page (col. 10, lines 30-32).

As per claim 9, Tavor et al. ('347) further discloses a making an offer to acquire a second product or service in said cobranded website (col. 9, line 46 – col. 10, line 32).

As per claim 10, Tavor et al. ('347) further discloses receiving an offer to acquire said second product or service in said cobranded website (col. 9, line 46 – col. 10, line 32).

As per claim 11, Tavor et al. ('347) further discloses either accepting or rejecting said offer or making a counter offer in said cobranded website (col. 9, line 46 – col. 10, line 32).

As per claim 12, Tavor et al. ('347) further discloses choosing not to make an offer or accept an offer to acquire said second product or service in said cobranded website (col. 9, line 46 – col. 10, line 32).

As per claims 80 and 140, Tavor et al. ('347) further discloses receiving, accepting or rejecting an offer to acquire said second product or service in said cobranded website (col. 9, line 46 – col. 10, line 32).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-3, 74-75, 134-135 and 196 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tavor et al. (US Patent Number 6,553,347).

As per claims 2, 74, 134, and 196 Tavor et al. ('347) is not limited by type of product or service, but does not specifically disclose the second product or service is an automobile rental, hotel reservation or airline ticket.

Official notice is taken that conditional purchase offers for airline tickets, hotel rooms, or rental cars are old and well known in the art, see assignee's reference Walker

et al. (US Patent Number 5,794,207) figure 5 (515) for the benefit of maximizing sales of products or services.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to sell airline tickets in the invention of Tavor et al. ('347) for the benefit of maximizing sales of products or services.

As per claims 3, 75, and 135, Tavor et al ('347) is not limited by type of product or service, but does not specifically disclose the first product or service is a hotel reservation or airline ticket.

Official notice is taken that conditional purchase offers for airline tickets, hotel rooms, or rental cars are old and well known in the art, see assignee's reference Walker et al. (US Patent Number 5,794,207) figure 5 (515) for the benefit of maximizing sales of products or services.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to sell airline tickets in the invention of Tavor et al. ('347) for the benefit of maximizing sales of products or services.

3. Claims 4, 6-7, 76, 78-79, 136, 138-139 and 197 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tavor et al (6,553,347), in view of Microsoft Office 2000 Professional Edition (hereinafter referred to as "Microsoft Office 2000").

As per claims 4, 76, 136 and 197, Tavor et al ('347) does not specifically disclose the use of email containing a hyperlink to a cobranded web site.



Official notice is taken that email for communications is old and well known in the art, see assignee's reference Walker et al (US Patent Number 5,794,207) col. 9, lines 52-59 for the benefit of maximizing communication options.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to communicate with email for the benefit of maximizing communication options.

Microsoft Office 2000 teaches, pages 450-451 embedded hyperlinks in email messages for the benefit of allowing mail recipients to quickly open a web page from an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to send an email message with a hypertext link to a cobranded web site for the benefit of allowing mail recipients to quickly open a web page from an email.

As per claims 6, 78, and 138, Tavor et al. ('347) does not specifically disclose a checkbox to defer the offer until a subsequent time.

However, Microsoft Office 2000 teaches, pages 471 and 480, a checkbox to defer the message to a later time for the benefit of allowing mail recipients to defer action on the content of an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a checkbox to defer the message to a later time for the benefit of allowing mail recipients to defer action on the content of an email.

As per claims 7, 79, and 139, Tavor et al. ('347) does not specifically disclose an email containing a hyperlink.

However, Microsoft Office 2000 teaches, pages 450-451 embedded hyperlinks in email messages for the benefit of allowing mail recipients to quickly open a web page from an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to send an email message with a hypertext link to a cobranded web site for the benefit of allowing mail recipients to quickly open a web page from an email.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tavor et al. (6,553,347), in view of Logan et al. (US Patent Number 6,199,076).

As per claim 14, Tavor et al ('347) does not disclose inquiring as to said second product or service and receiving through an interactive voice mail feature a referral to said supplier-partner.

However, Logan et al ('076) teaches the equivalence of voicemail or email files, see column 3, lines 42-56 and column 6-45 for the benefit of convenience to the user.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email or voicemail as is most convenient to the user.

Microsoft Office 2000 Edition teaches, pages 450-451 embedded hyperlinks in

email messages for the benefit of allowing mail recipients to quickly open a web page from an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to send an email message with a hypertext link to a cobranded web site for the benefit of allowing mail recipients to quickly open a web page from an email.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) McCausland et al. (US Patent Number 6,049,599), which discloses a churn amelioration system and method therefor.

2) Sullivan et al. (US PG Pub. 2001/0018665), which discloses a system and method for administering promotions.

3) Aggarwal et al. (US Patent Number 6,886,000), which discloses on-line negotiations with dynamic profiling.

4) Forlai (US Patent Number), which discloses a method and apparatus for generating sale offer over an electronic network system.

5) Black et al. (US Patent Number 6,754,833), which discloses a method for generating and distributing telecom and Internet revenue.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-

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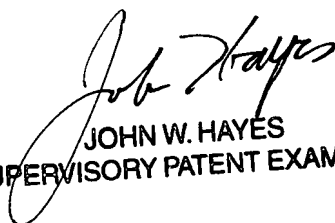
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7076. The examiner can normally be reached on Monday -Wednesday and Friday,  
10:00 AM -6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FAN 11/23/2007



JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER